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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,353	02/06/2004	Wledon J. Peters	37688-199395	5047

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EXAMINER


ROYAL, PAUL

ART UNIT PAPER NUMBER

3611

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/772,353	Applicant(s) PETERS, WLEDON J.	
	Examiner Paul Royal	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/02/04, 07/15/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) (which is form PTO-892, paper #2 from Application 09/983,273) submitted on 16 July 2004 and 2 July 2004 has been considered by the examiner. Note, both the 16 July 2004 and 2 July 2004 submissions are identical.

Specification

2. The disclosure is objected to because of the following informalities: Note, the parent application, 09/983,273, filed on October 23, 2001, has now issued as Patent 6,698,785. The first paragraph of the instant applicant must be appropriately updated to reflect the issued status of the parent application.

Further, with respect to page 13 paragraph 00034, it is unclear how the plate member 904 engages a collar hitch. Applicant's reference to Figure 3 did not clarify the disclosure.

Appropriate correction is required.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hitch receiving member 89", must be shown or the feature(s) canceled from the claim(s). See also the Specification at page 9, line 19. No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 2 recites the limitation "receiving member" in 2. There is insufficient antecedent basis for this limitation in the claim. As best understood and in the interest of prosecution the application on the merits, the phrase "receiving member" is the same as applicant's retaining member.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 8 and 9 of U.S. Patent No. 6,698,785. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-2, 8 and 9 of U.S. Patent No. 6,698,785 are drawn to a hitch mounting assembly as indicated below which includes the same elements with different element nomenclature but having the same structural relationships as the instant application.

Firstly, note the instant application is a hitch receiving assembly where U.S. Patent No. 6,698,785 is a hitch mounting assembly. Although the preamble of the instant invention and U.S. Patent No. 6,698,785 recite different terminology they represent identical structural elements.

Specifically, U.S. Patent No. 6,698,785 claims an elongate floating torsion member and an elongate fixed member, each having a substantially square cross section, see claim 9, including a plurality of resilient members, see claim 8, where the instant application respectively recites a retaining member and an elongate fixed member, see claim 1, having a substantially square cross section, see claim 7, including a plurality of resilient members, see claim 6. Also, U.S. Patent No. 6,698,785 claims the elongate fixed member is inside the elongate floating torsion member wherein the instant application uses terminology stating the fixed member is inside the retaining member, see claim 2 (where receiving member" is understood to be "retaining member" – as indicated in the **35 USC § 112** rejection above).

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For claims 3 and 5 of the instant application the broad limitation "hitch receiving member" of U.S. Patent No. 6,698,785 encompasses the "receiving means", including a tongue adapted to receive a ball hitch, and a king-pin hitch of the instant application because ball and tongue hitches, and king-pin hitches are commonly used as hitch receiving members when towing vehicles.

Note, although all of the terms the instant application and U.S. Patent No. 6,698,785 are not the same, they represent the same structural components and thus U.S. Patent No. 6,698,785 encompasses the invention of the instant application.

For claim 8 of the instant application, while U.S. Patent No. 6,698,785 does not clearly state a flexing capability in the claims, it presents a fixed transverse core member/elongate fixed member which can be flexed along its length because virtually any element can be flexed along its length if the required amount of force is properly applied and the claim does not present any limitations on the applied force.

For claim 9 of the instant application, while U.S. Patent No. 6,698,785 does not clearly state the fixed member is a torsion member, the structure of the fixed transverse core member/elongate fixed member is that of a torsion rod.

Further, where claim 4 of the instant application is drawn to a hitch assembly which includes a ball hitch and a hitch receiving assembly, the hitch mounting assembly of U.S. Patent No. 6,698,785 includes a ball hitch with a hitch mounting assembly which provides the same structural elements as the hitch receiving assembly and/or the hitch assembly of the instant application.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simmons teaches a trailer hitch. Hixon teaches a truck-trailer hitch. Smalley teaches a hitch. Speer teaches an apparatus for connecting carriers. Gullickson teaches an energy dampening drawbar. Van Vleet '560 teaches a trailer hitch. Van Vleet '415 teaches a cushion coupler. Jerry teaches a trailer hitch. Carty teaches a coupler assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 703-308-8570. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



P. Royal
November 17, 2004

Paul Royal
Examiner
Art Unit 3611



LESLEY D. MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600